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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DCK BKT NO.	CONFIRMATION NO.
09/708,569	11/09/2000	Makoto Endo	35.C1-4920	2291

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/708,569	ENDO ET AL.	
Examiner	Art Unit	
Pamela R. Schwartz	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23, 24, 27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 24, 27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Claims 24 and 29-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,460,989. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent, directed to an ink set, recite the inclusion of coloring material and fine particles which adsorb the coloring material in a monomolecular state. See claims 1, 3, 4, and 10-12. Since the ink set would be used to make the instantly claimed invention, and the particulars of how to make the claimed imaged article are recited by the patent claims, instantly claimed invention is obvious therefrom.

2. Claim 24 and 29-32 are is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,659,601. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented recording method discloses an ink and a liquid composition, the liquid composition containing fine particles, wherein the coloring material is adsorbed on the surfaces of the fine particles in a monomolecular state such that the particles aggregate to each other and with the surfaces of the particles being charges with a polarity opposite to that of the ink. See claims 1,12 and 16. Since the recording method would be used to make the instantly claimed invention, and the particulars of how to make the claimed imaged article are recited by the patent claims, instantly claimed invention is obvious therefrom.

3. Claims 24 and 29-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of U.S.

Patent No. 6,517,199. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent discloses a liquid composition for forming a colored area of an image on a medium by application of charged ink containing a coloring material wherein the aqueous ink composition contains fine particles that adsorb the coloring material of the ink a monomolecular state. See claims 2, 6, and 8. Since the aqueous liquid composition would be used to make the instantly claimed invention, and the particulars of how to make the claimed imaged article are recited by the patent claims, instantly claimed invention is obvious therefrom.

4. Claims 23, 24, 27 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Field et al. (6,420,039) for reasons of record and for reasons given below. Applicants have added a method limitation to claim 24 reciting that the color portion is formed by bringing the coloring material in an ink and a liquid composition containing fine particles in contact with each other in a liquid state. Since the claims are directed to a final product, this limitation is patentably significant only if the method of making limitation renders the claimed article structurally distinct from articles made by the method of the prior art. The examiner has not found such a teaching in the specification. Applicants are invited to point to such a showing in order to overcome this rejection.

5. Applicant's arguments filed March 23, 2004 have been fully considered but they are not persuasive. It is noted that the typographical error in the rejection over Goto et al. (6,659,601) has been corrected. The examiner acknowledges clarification presented with respect to applicants' copending applications. With respect to the obviousness

type double patenting rejections, that applicants are considering filing of a terminal disclaimer is acknowledged. These rejections will be maintained until an acceptable terminal disclaimer is filed.

With respect to the art rejection, applicants argue that if the image is formed with the ink and the fine particles coming into contact in a liquid state, the thickness of the ink receptive layer can be reduced and the texture of the medium can be improved, i.e. that the article will be structurally distinct from that of the prior art. However, claim 24 includes no limitations concerning the thickness of the ink receiving layer or the texture of the surface of the medium, and there is nothing inherent in the claim language that requires less coating or an improvement in texture. In addition, when the aqueous ink is applied to the medium, the fine particles and the ink will contact each other in a liquid state since the vehicle from the ink will be present.

6. Zaima et al. (6,527,843) is cited as disclosing fine colored particles for use in ink jet ink. The colored particles may be formed by adsorbing dye on the surface of oppositely charged metal oxide particles. This may be accomplished by incorporating the dye into a dispersion of the metal oxide. See col. 4, lines 50-55, col. 5, lines 58-62, and col. 6, lines 4-6.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
May 30, 2004



PAMELA R. SCHWARTZ
PRIMARY EXAMINER